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EXAMINER

CHUNG TRANS, XUONG MY

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. SWANTNER, SHANE BROWN,
and DOUGLAS G. SEYMOUR

Appeal 2007-3822
Application 10/759,637
Technology Center 2800

Decided: April 15, 2008

Before MAHSHID D. SAADAT, ROBERT E. NAPPI,
and KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-5. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to an electrical connector. According to Appellants, one aspect of the invention entails an insulating body surrounding an electrically conductive member and pin. Another aspect

entails the insulating body comprising at least one compressible leg. (Spec. 5: par. 0022; Abstract, Fig. 3).

Claims 1 and 3 are illustrative of the claims on appeal:

1. A connector comprising:

an electrically conductive member having a longitudinal section at least a portion of which provides a cylindrical hollow end;

an electrically conductive pin positioned with respect to said electrically conductive member, a first part of said electrically conductive pin being substantially centrally located within said hollow end: and

a single-piece electrically insulating body surrounding said electrically conductive member and said electrically conductive pin, said electrically conductive member having at least one leg extending in a direction transverse to said longitudinal axis and having a length sufficient to extend beyond a surface of said electrically insulating body.

3. The connector of Claim 1 wherein said electrically insulating body is provided with at least two spacing feet and at least one compressible leg.

The Examiner relies on the following prior art references:

Tanaka	US 4,556,264	Dec. 3, 1985
Sheesley	US 4,666,231	May 19, 1987

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Sheesley.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheesley in view of Tanaka.

ISSUES

For claim 1, the issue is whether Sheesley discloses an “insulating body *surrounding* said electrically conductive member and said electrically conductive pin.”

For claim 3, the issue is whether the Examiner has established a prima facie case that the collective teachings of Sheesley and Tanaka teach the limitation of “said electrically insulating body is provided...at least one *compressible* leg.”

We affirm-in-part.

PRINCIPLES OF LAW

1. *Anticipation*

“Implicit in our review of the [Examiner’s] anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation.” *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). During examination proceedings, claims are “given their broadest reasonable interpretation consistent with the specification”. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Although claims are to be interpreted in light of the specification, limitations from the specification are not to be read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). The scope

of a disputed term is not limited by the preferred embodiments absent an express disclaimer by Appellant of a broader definition. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

2. *Obviousness*

On appeal, Appellant bears the burden of showing that the Examiner erred. Appellant may sustain this burden by showing that, where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art would have done what Appellant did. *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick, Co.*, 464 F.3d 1356, 1360-61 (Fed. Cir. 2006). Appellant may also show that the Examiner has failed to meet his initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that initial burden is met, then the burden shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence. *Id.*

The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d at 988 (Fed. Cir. 2006).

Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account

of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

FINDINGS OF FACT (FF)

1. Sheesley discloses an insulative body 29 having a cavity 40 with cavity portions 40 and 42 encircling, enclosing, and receiving portions of electrical terminal 12 (col. 4, ll. 3-35, Figs. 1-3, 6-7). Electrical terminal 12 comprises a split tubular shell portion 13 and an elongated blade portion 14. The end of the blade 14 serves as a terminal end 17, projecting out of the cavity 40 for connection to a circuit board 50 (col. 3, ll. 1-15, col. 4, ll. 34-35, col. 5, ll. 32-37, Figs. 1, 3, 6). Contact 2 having tube 3 is received in center contact receiving cavity 36 extending axially of the insulative body (col. 3, ll. 55-66, Fig. 5). “A hollow cylindrical web 39 of the insulative body 29 concentrically encircles the tube 3” (col. 3, ll. 62-63). Cavity 36 also extends axially of the insulative body 29 and receives the blade portion 5 of contact 2, with terminal end portion 6 projecting outwardly of the cavity 36 (col. 3, l. 64 to col. 4, l. 2, Fig. 5) for connection to the circuit board 50 (col. 5, ll. 32-37).

2. Tanaka discloses mounting legs 18 so that “it is possible to fix the body 1 in a printed circuit board (not shown) by bringing the legs into

resilient engagement with fitting holes of the printed board.” (Col. 4, ll. 45-50).

3. Appellants disclose a “single-piece electrically insulating body 32” having “at least one but preferably two compressible legs 36” (Spec. 5: par. 0022; Fig. 3).

4. Appellants depict portions of the connector 19 at Figure 3 as outside of the insulating body 32 and not touching the circuit board in at least two areas: 1) between the circuit board 50 and the body 32, and 2) below the circuit board, so as to be exposed to the environment.

ANALYSIS

1. 35 U.S.C. § 102 Rejection

Appellants argue that Sheesley’s single-piece electrically insulating body 29 does not surround the electrically conductive member 12 and electrically conductive pin 2 (Br. 2). Appellants base their argument on the following:

The term “surrounding” as used in the specification and claims and as shown in the drawings (see Fig. 3 of the subject application) is obviously to be interpreted as meaning that the electrical components are covered by an insulating material except where necessary for electrical connection to be made thereto.

A review of the Sheesley reference...clearly shows that the electrical contacts (members or pins) are not “surrounded” by an insulating body as required by the claims. Actually,

entire sections of the Sheesley contacts 20, 6, and 17 have exposure to the environment, as seen in Fig. 2 of Sheesley.

(Br. 2-3).

The Examiner counters that “the electrical member 12 and pin 2 are surrounded by an insulating body (29)” because “[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.” (Ans. 6).

We agree with the Examiner’s position. Appellant’s argument that portions of Sheesley’s conductive pin 2 and member 12 are not surrounded by the insulating body amounts to a tacit acknowledgement that portions thereof are surrounded. Appellants’ claim 1 does not require the whole pin or member to be surrounded, nor does it specify the degree of “surrounded.”

Our determination is consistent with the Specification, since, contrary to Appellants’ characterization, *supra*, the disclosed conducting pin 22 and member 19 (Fig. 3), like Sheesley’s, are not surrounded by the insulating body everywhere “except where necessary for electrical connection to be made thereto” (Br. 2, FF 4, Sheesley, Fig. 4). At a minimum, the conducting pin section 22 and member 19 section below the circuit board 50 are not required for electrical connection to the circuit board since they can be eliminated. (See Spec. Fig. 3). Further, “entire sections of” Appellants’ conducting pin 22 and member 19 above and below the circuit board 50

“have exposure to the environment” (Br. 3, *supra*; FF 4; Spec. Fig. 3). Accordingly, Appellants’ claim lacks support for the argued distinctions.¹

Consequently, we concur with the Examiner’s determination that Sheesley’s single-piece electrically insulating body 29 surrounds conducting pin 2 and member 12 as claimed, because the pin and member are not only depicted as surrounded, but are also described as within cavities of and encircled by the insulating body (FF 1).

In view of the above discussions, since Sheesley discloses the argued claim limitations, the Examiner’s rejection of independent claim 1, and dependent claims 2, 4 and 5 not separately argued by Appellants, is sustained.

2. 35 U.S.C. § 103 Rejection

Turning to claim 3, we agree with Appellants that the combination of Sheesley and Tanaka does not suggest “at least one compressible leg” (Br. 3). As Appellants correctly point out, the Examiner cited Tanaka for teaching the “compressible leg.” But, as Appellants argue, Tanaka teaches “deflectable” and “resilient” legs (Br. 3, FF 2). In our view, the Examiner

¹ Even if Appellants’ disclosed pin and member were as Appellants describe, (i.e., surrounded by the insulating body everywhere except as necessary for electrical connection), our broader determination of the scope of “surrounded” would not be inconsistent with the Specification. A difference in the degree of “surrounded” is not a difference in kind.

does not respond directly to the Appellants' argued distinction between Tanaka's resilient leg and Appellants' compressible leg (Br. 3, Ans. 7).

While we note that the term "compressible" is not defined in the Specification, we find the plain and ordinary meaning of the term to be distinct from "deflectable" or "resilient." *In Meyers Multi District Patent Infringement Litigation*, Nos. 95-1194 to 95-1198, 1996 WL 84667, at *2, 78 F.3d 605 (Fed. Cir. Mar. 28, 2006) ("Meyers improperly equates the term 'resiliency' in the Cavanaugh patent with 'compressibility'.").

Accordingly, based on the Examiner's stated interpretation of the teachings of the prior art with respect to claim 3 as outlined, *supra*; we determine that the Examiner has not provided a rational underpinning to support a legal conclusion of obviousness.

CONCLUSION

Appellants have failed to show error in the Examiner's rejection as to claim 1. *In re Kahn*, 441 F.3d at 987-88. Accordingly, we sustain the Examiner's rejection of claim 1. Since Appellants have not separately argued claims 2, 4, and 5, we also sustain the Examiner's rejection of claims 2, 4 and 5.

On the other hand, Appellants have shown that the Examiner erred in rejecting claim 3. Accordingly, we will not sustain the Examiner's rejection of claim 3.

DECISION

The decision of the Examiner is *affirmed-in-part*. The Examiner's decision rejecting claims 1, 2, 4, and 5 is affirmed. The Examiner's decision rejecting claim 3 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED-IN-PART

gvw

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